

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1, 4, 5, 7-27 and 30-92 are in the application. Claims 53-92 were previously withdrawn without prejudice or disclaimer of subject matter.

Claims 3 and 29 are hereby canceled. Claims 1 and 27 are independent. Claims 1, 4, 5, 27, 30 and 31 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. REJECTIONS UNDER 35 U.S.C. §103

Claims 1, 3-5, 7-27 and 29-52 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,598,216 to Lee in view of U.S. Patent No. 6,404,817 to Saha et al. (hereinafter merely "Saha") and U.S. Patent No. 5,978,817 to Jung et al. (hereinafter merely "Jung").

Applicant respectfully traverses this rejection.

Independent claim 1 is representative and recites, *inter alia*:

“wherein said extraction step includes a step of performing inverse transform of transforming said compressed domain only for the blocks of high relevance selected by said metric calculating step and of performing motion compensation for a prediction coded macroblock or a bidirectionally prediction coded macroblock”

The above feature is not taught or suggested by the cited references.

The Office Action asserts Lee discloses motion compensation for a prediction coded macroblock and Saha teaches IDCT processing. The Office Action then makes the conclusory statement, “it would have been considered an obvious design choice to a person or ordinary skill in the relevant art to apply inverse transform of transforming the compressed domain to [sic] only for the blocks of high relevance selected by the metric calculation means as an efficient way to estimate motion.” Applicants contend the Office Action is asserting Official Notice and relying on impermissible hindsight.

APPLICANTS CHALLENGE THE FACTUAL
ASSERTIONS AS NOT PROPERLY OFFICIALLY
NOTICED OR NOT PROPERLY BASED UPON
COMMON KNOWLEDGE.

The Examiner’s reasons to combine Lee with Saha seem to come from the Examiner’s own deduction that such a combination would be advantageous and, as such, are tantamount to Official Notice.

From the MPEP 2144.03(E): “Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to ‘fill in the gaps’ in

an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092.”

Further, “[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).” MPEP 2144.03 (emphasis added).

First, the Office Action, at page 5, states Lee discloses motion compensation for a prediction coded macroblock and Saha teaches IDCT processing. The Office Action then without any support makes the conclusory statement, “it would have been considered an obvious design choice to a person or ordinary skill in the relevant art to apply inverse transform of transforming the compressed domain to [sic] only for the blocks of high relevance selected by the metric calculation means as an efficient way to estimate motion.” Moreover, Applicants challenge the Examiner to provide a reference that suggests the combination without using Applicants’ specification as a blueprint.

Applicants contend the Office Action depends on mere conclusory statements and an impermissible reliance on Official Notice as the reason to combine Lee and Saha. The combination can not be characterized as of notorious character or insubstantial, as asserted in the Office Action. Certainly, the combination of features recited in those claims is not capable of “instant and unquestionable demonstration as to defy dispute.” These features are neither “basic knowledge” nor “common sense.” *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’”).

The recited element of claim 1 is not a mere substitution of one known element for another having a predictable result. Indeed, the claimed element is part of a complex arrangement of elements neither intuitive nor instantly recognizable. Applicants contend that claims 1 and 27 recite substantive features that can not be overcome with Official Notice.

Thus, in accordance with MPEP 2144.03(D) and so that the record of prosecution be complete, Applicants respectfully request documentary evidence under 37 C.F.R. 104(c)(2) of the elements recited in claim 1 and 27, or an affidavit of the Examiner under 37 C.F.R. 104(d)(2) setting forth specific factual statements and explanation to support the facts asserted to combine the cited references.

APPLICANTS ASSERT THE OFFICE ACTION
RELIES ON IMPERMISSIBLE HINDSIGHT

The Office Action makes the conclusory statement, “it would have been considered an obvious design choice to a person of ordinary skill in the relevant art to apply inverse transform of transforming the compressed domain to [sic] only for the blocks of high relevance selected by the metric calculation means as an efficient way to estimate motion.” However, the Office Action provides no analysis to satisfy the conclusion. Applicant respectfully requests an analysis using the Graham factors:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

In view of the guidance provided by the Supreme Court in *KSR International Co. v. Teleflex Inc.* 127 S. Ct. 1727 (2007), the Office Action must articulate a reason or rationale to support an obviousness rejection under 35 U.S.C. § 103. The rationale should be based on the state of the art and not on impermissible hindsight (e.g., improper-hindsight reasoning using applicant's disclosure).

Applicant respectfully requests the Office Action provide findings of fact concerning the state of the art and the teachings of the references applied. Moreover, Applicant respectfully requests explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. That is, the Office Action fails to provide as required under KSR:

(1) a finding that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

“It can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”

KSR at 1765. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

Alternatively, the Office Action does not justify the obviousness rejection as a use of known technique to improve similar devices in the same way. Applicant respectfully requests, under this support for an obviousness rejection:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the present device can be seen as an “improvement;”

(2) a finding that the prior art contained a comparable device (method, or product) that was improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Thus, Applicants contend, independent claim 1 is patentable over Lee, Saha and Jung because those references taken alone or in combination do not disclose each and every element recited in the claims.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claim 27 is also believed to be patentable.

III. DEPENDENT CLAIMS

As stated above, the dependent claims depend from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 1, 4, 5, 7-27 and 30-52 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

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